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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,223	06/27/2001	Shane M. Kelton	163.1062USD1	5643

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EXAMINER

DICUS, TAMRA

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/893,223	KELTON ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Tamra L. Dicus	1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 01 September 2004.  
 2a) This action is **FINAL**.                                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-35 and 37-47 is/are pending in the application.  
 4a) Of the above claim(s) 1-35,37,43 and 44 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 38-42 and 45-47 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

The RCE is acknowledged. The claim objections and 112 rejection of the prior Office Action is withdrawn due to Applicant's amendments.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 38-40 and 45-47 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Newly amended claim 45 introduces the following limitation: "a tile floor whose tiles have a floor surface". The originally filed specification does not contain any description on a tile floor having a plurality of tiles.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 38-40 and 45-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "a tile floor whose tiles have a floor surface" is not clear. It is not understood where the tiles are in conjunction to a tile floor. Further, it is not clear to the structure of the tile, e.g. does "a floor surface" indicate an upper surface or a bottom surface? Further, the term, "new tile", is a relative term and thus, indefinite. The originally filed

specification does not define what is meant by "new". What makes the tile of the instant application "new" or different from any tile, outside the fact that it's "old"? Further, to instant claim 45, "small" is also a relative term, applicant does not define in the originally filed application what "small" means.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 38-40 and 45-47 are rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention.

7. An issue of public use or on sale activity has been raised in this application. In order for the examiner to properly consider patentability of the claimed invention under 35 U.S.C. 102(b), additional information regarding this issue is required as follows: Per Applicant's own admission on page 49, lines 18-19 continuing to page 50, Applicant states the quarry tile tested (including the new, untreated, core, and restored tiles) is sold by the American Olean Co. under the trademark Canyon Red™. Thus if the instant claims have a tile floor having an elemental composition substantially the same as that of the core of a new, untreated tile, then the elemental composition of the claimed tile floor is the same as what is commercially sold by American Olean Co. (the Canyon Red™ tile). The core of a new untreated tile would inherently be expected to function as the substantially the same elemental composition of the claimed tile floor

and thus inherently exhibit the slip-resistant property. Further, by Applicant's own admission, quarry tile naturally has microscopic (small) peaks and valleys at pg. 3, lines 5-6. Tiles are well known as flooring material having surfaces. coefficient of friction is an inherent property of the tile itself. Because the instant claim states the tile floor is "substantially the same" as a new untreated tile, then how is the tile floor different from what is already sold?

Applicant is reminded that failure to fully reply to this requirement for information will result in a holding of abandonment.

2. Claims 38-42 and 45 are rejected under 35 U.S.C. 102(b) as being anticipated over USPN 5,314,554 to Owens.

Owens teaches a method of producing a laminated tile, where quarry tile is suitable for use and the tile composition is of 60-75% by weight silica and 15-25 % by weight alumina at col. 7, lines 1-40. Owens teaches the tile product may be cut to form smaller tiles (a tile floor whose tiles equivalency) at col. 4, lines 33-34. The coefficient of friction is an inherent property of the tile itself. Because the tile of Owens is made of the components as Applicant claims, the claimed features would therefore be inherent (e.g. slip-resistant and floor surface). Owens does not state *per se* that the tile has an elemental composition substantially the same as that of the core of a new, untreated tile; however, Owens does teach after processing the tile it is finished (col. 14, line 2) which the Examiner interprets as "new" because Owens does not teach the tile aged at that point in time. Further, the tile is not a different product because it is new, or wet or dry, clean or soiled. While Applicant refers to new small peaks and valleys, to which Owens does not state *per se*, such variation is naturally inherent to quarry tiles. Per Applicant's own admission, the quarry tile naturally has microscopic peaks at pg. 3, lines 5-6. Further Owens

teaches microscopic (encompasses “small”) pores and crevices on the upper surface at col. 8, lines 1-2 and also at col. 10, providing protrusions and reservoirs. Owens further provides an underlying core, 4 in Figure 2 of various types of quarry tile compositions at col. 7, lines 10-45 and of ceramic. The tile configuration and structure includes an underlying region of the same material-quarry, which is on an upper region/surface also. Additionally, there are subsequent layers, more than one, which may be applied to the substrate of natural stone material; thereby providing a laminate structure. While Owens does not state in the same words, e.g. a tile floor whose tiles have a floor surface and has an elemental composition substantially the same as that of the core of a new, untreated tile, the upper layers of Owens are still of the same material, because the entire tile material is made of quarry, which includes an underlying region of quarry and an upper surface of quarry elemental composition. Because the same quarry material is provided, the quarry would be expected to function as a floor tile, thus having a floor surface.

*Response to Arguments*

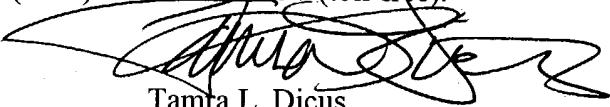
Applicant argues Owens does not teach floor tiles. However, Owens would be expected to function as a floor tile because the same quarry tile is provided. Owens is still used to provide this teaching as explained above. The Examiner suggests reviewing the American Olean website non-patent literature enclosed herein that describes Canyon Red having a slip-resistant, unglazed surface that are tiles for a floor or wall. Cleaning something already taught or sold is not germane to patentability.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tamra L. Dicus  
Examiner  
Art Unit 1774

September 29, 2004



Rena DYE  
SUPERVISORY PATENT EXAMINER

A.O.1774